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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,155	09/19/2003	Chris C. Zank	PECL-0009	7096

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EXAMINER
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JULES, FRANTZ F

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

10/666,155

## Applicant(s)

ZANK ET AL.

## Examiner

Frantz F. Jules

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 5 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/14/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 10-11 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hume (US 2,122,065).

Hume discloses a wheel-balancing weight for mounting to a wheel with a flange, the weight comprising a weighted body (2) and a clip (3) securely attached thereto, the clip having a gripping section and the body having a gripping portion generally opposite the gripping section of the clip, the gripping section of the clip and the gripping portion of the body in combination defining a compartment therebetween as seen in the figures, the compartment for receiving the flange therein when the weight is mounted thereto such that the gripping section of the clip and the gripping portion of the body are on opposite sides of the flange and grip the flange therebetween.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 6-9 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hume (US 2,122,065).

#### Claims 6-8 and 16-18

Regarding using a number of protrusions extending from the weighted body and a like number of apertures in the clip corresponding to a protrusion on the body as recited in claims 6-8 and 16-18, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Humel to include the use of a number of protrusions extending from the weighted body and a like number of apertures in the clip corresponding to a protrusion on the body in his advantageous system, as the duplication /reduction of identical parts which perform essentially the same function is a common occurrence throughout the wheel-balancing weight design art, and the specific number of protrusions and like number of apertures in each clip used would have been an obvious duplication of parts, depending upon such common factors as the amount of unbalance in the wheel, the yield strength of the balance weight material, the number of balance weight used; the ordinarily skilled artisan choosing the best number of protrusions and like number of apertures through the clip which would most optimize the cost and performance of the device for a particular application at hand, based upon the above noted common design criteria.

#### Claims 9 and 19

Regarding using a weight body constructed steel as recited in claims 9 and 19, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hume to include the use of a weight body constructed of steel in his advantageous

system, as balancing weight material selection is a common and everyday occurrence throughout the balancing weight design art and the specific use of a weight body constructed of steel would have been an obvious matter of design preference depending upon such factors as the amount of unbalance force in the wheel, the yield strength of the balance weight material; the ordinarily skilled artisan choosing the best stress profile corresponding to a particular loading imposed on the wheel which would most optimize the cost and performance of the device for a particular application at hand, based upon the above noted common design criteria.

5. Claims 2-4 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hume as applied to claim s1 and 11 above, and further in view of McCrorey (US 2,548,842) and Sakaki et al (US 6,364,422).

Hume teaches all the limitations of claims 2-4 and 12-14 except for a wheel balancing weight comprising a weighted body comprising a number of apertures therethrough including a like number of apertures in the clip receiving attaching members. The general concept of providing hole in a weighted body and in a clip to receive an attaching member is well known in the art as illustrated by McCrorey which discloses the teaching of a wheel balancing weight which is secured by an attaching member which extends through a clip and through a weighted body. Also, the general concept of providing a plurality of holes in a clip as well as attaching members for securing a balance weight to the flange of a wheel constitute an obvious duplication of parts which achieve the same function and is well known in the art as illustrated by Sakaki et al which disclose the teaching of multiple holes (13A) in a clip used to secure a balancing

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weight to the flange of a wheel. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hume to include the use of attaching member extending through holes of a clip and of the weighted body to secure the balance weight to the wheel in his advantageous system as taught by McCrorey in order to provide flexibility in using different size weights in balancing the wheel. In addition, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hume to include the use of a plurality of attaching members through holes in the clip and in the weighted body for securing of the balance weight in his advantageous wheel balancing weight in order to improve the stability of balance weight while exposed to cyclic loading on a vehicle.

#### ***Allowable Subject Matter***

6. Claims 5 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Oba et al, Hume are cited to show related wheel balancing weight comprising clip with a compartment between the clip and the weight for securing the balance weight.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz F. Jules whose telephone number is (703) 308-

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8780. The examiner can normally be reached on Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph S. Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz F. Jules  
Primary Examiner  
Art Unit 3617

FFJ

December 1, 2004

FRANTZ F. JULES  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Frantz F. Jules', written over a horizontal line.